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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,487	05/10/2001	Robert M. Best	493-25-3	7727

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EXAMINER

WHITE, CARMEN D

ART UNIT PAPER NUMBER

3714

DATE MAILED: 08/12/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/853,487

Applicant(s)

BEST, ROBERT M.

Examiner

Carmen D. White

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 59-207 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 59-207 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 59-71 and 136-144, drawn to a game system that comprises a video game apparatus having a first processor for executing a first game program that generates first picture data representing a portion of a 3-dimensional simulated game world including a first player character viewed from a variable first viewpoint, classified in class 463, subclass 32.
- II. Claims 72-83, 93-103, 104-110, 123-129, 153-154, 158-162 and 166-174, drawn to a method of operating a video game system that includes executing a first game program and a second game program and generating data to specify movements of plural body parts, classified in class 463, subclass 30.
- III. Claims 84-92, drawn to a method of operating a video game system that includes generating location data in the first game apparatus to specify relative locations of at least one of the components of a moving object, classified in class 463, subclass 30.
- IV. Claims 111-115, drawn to a method of operating a video system that includes executing a second game program by the first processor to generate second picture data that represent a reduced resolution portion of a moving picture of a moving object, classified in class 463, subclass 31.

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- V. Claims 116-122 and 163-165 drawn to a method of operating a video game system that includes executing a third game program by the second processor to process transferred second picture data, classified in class 463, subclass 31.
- VI. Claims 130-135, drawn to a game system comprising a portable game apparatus having a display device, a boot ROM storing a first game program and a first game program that sends power-up data to a second game apparatus classified in class 463, subclass 43.
- VII. Claims 145-152 and 155-157, drawn to a digital storage device for controlling the operation of a game system classified in class 463, subclass 43.
- VIII. Claims 175-199, drawn to a method for use in a video game system that includes generating and transferring identification data to and from a second processor classified in class 463, subclass 30.
- IX. Claims 200-206, drawn to a method of operating a video game system that includes executing the second game program to generate second picture data representing a miniature likeness of the character classified in class 463, subclass 30.
- X. Claim 207, drawn to a method of operating a video game system that includes executing the second game program to generate second picture data representing a control indicator and a character classified in class 463, subclass 30.

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The inventions are distinct, each from the other because of the following reasons:

Inventions II, III, IV, V, VIII, IX and X are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility as a method for executing a first and second game program and generating data to specify movements of plural body parts; invention III has separate utility such as a method that generates location data to specify locations of components of a moving object; invention IV has separate utility such as a method for generating second picture data that represents a reduced resolution a moving object; invention V has separate utility such as a method for executing a third game program by a second processor; invention VIII has separate utility such as method of generating and transferring identification data; invention IX has separate utility such as a method for generating second picture representing a miniature likeness of a character; invention X has separate utility such as a method for generating second picture data representing a control indicator. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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This application contains claims directed to the following patentably distinct species of the claimed invention: Group (I) that is drawn to a method for generating first picture data representing a portion of a 3-D simulated game. Group (VI), drawn to a game system that has a boot ROM for storing a first game program and first game program that sends power-up data. Group (VII), drawn to a digital storage device for controlling the operation of a gaming system. These three inventions disclose distinctly embodied inventions, which are different from each other and the Groups of II, III, IV, V, VIII, IX and X, listed above.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

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the prior art, the evidence or admission may be used in a rejection under 35

U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


USPTO Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen D. White whose telephone number is 703-308-5275. The examiner can normally be reached on Monday through Friday, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7768 for unofficial communications and 703-305-3579 for official communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.


cdw


S. THOMAS HUGHES
SUPERVISORY PATENT EXAMINER
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